

PTO/5B/21 (09-04)

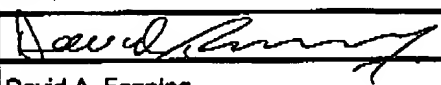
Approved for use through 07/31/2006. OMB 0651-0031

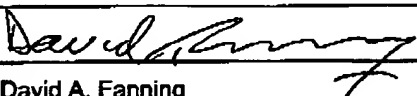
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/929,238	
	Filing Date	August 13, 2001	
	First Named Inventor	Stephen F. Gass	
	Art Unit	3724	
	Examiner Name	Ghassem Alie	
Total Number of Pages in This Submission	10	Attorney Docket Number	SDT 315

RECEIVED  
CENTRAL FAX CENTER  
JUL 11 2006

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	SD3, LLC	
Signature		
Printed name	David A. Fanning	
Date	July 11, 2006	Reg. No. 33,233

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.		
Signature		
Typed or printed name	David A. Fanning	Date July 11, 2006

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED  
CENTRAL FAX CENTER  
JUL 11 2006

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of

Date: July 11, 2006

STEPHEN F. GASS

Serial No.: 09/929,238

Examiner Ghassem Alie

Filed: August 13, 2001

Group Art Unit 3724

For: MITER SAW WITH IMPROVED SAFETY SYSTEM

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

**REPLY BRIEF****1. Real party in interest.**

The real party in interest is identified in the Appeal Brief.

**2. Related appeals and interferences.**

An update of the prior and pending appeals listed in the Appeal Brief follows:

1. Appeal of application serial number 09/929,227 (appeal brief and examiner's answer filed, reply brief due July 22, 2006).
2. Appeal of application serial number 09/929,242 (fully briefed).
3. Appeal of application serial number 10/053,390 (appeal brief and examiner's answer filed, reply brief due August 16, 2006).
4. Appeal of application serial number 10/100,211 (fully briefed).
5. Appeal of application serial number 10/189,027 (appeal brief filed, awaiting examiner's answer).
6. Appeal of application serial number 11/098,984 (appeal brief due August 30, 2006).

Applicant has also filed appeals in applications 09/929,221, 09/929,240, 09/929,425, 09/929,426, 10/189,031, 10/243,042 and 10/292,607, but those applications have either been allowed or prosecution has been reopened, so the appeals are no longer pending. Applicant identifies these prior appeals because the applications involved may be related to the present application.

### **3. Status of claims.**

The statement of the status of the claims is in the Appeal Brief.

### **4. Status of amendments.**

All amendments have been entered.

### **5. Summary of claimed subject matter.**

The claimed subject matter is summarized in the Appeal Brief.

### **6. Grounds of rejection to be reviewed on appeal.**

The grounds of rejection presented for review are set forth in the Appeal Brief.

### **7. Argument.**

This reply brief addresses the examiner's answer to the appeal brief and the obviousness rejections of claims 9 and 30.

#### **I. Claim 9.**

In the appeal brief applicant argued that the obviousness rejection of claim 9 should be reversed because: 1) there is no reasonable expectation that the combination of references proposed by the examiner would succeed, 2) the references teach away from the claimed combination, 3) there is no teaching, suggestion or motivation to combine the references in the manner proposed by the examiner, and 4) there are

objective indicia of non-obviousness. The examiner's responses to these issues are addressed below.

1. No reasonable expectation of success.

There is no reasonable expectation that the braking and detection systems of Lokey and Yoneda could be successfully implemented in a miter saw as disclosed in Brundage or Suzuki because the resulting saw would be unsafe. The saw would be unsafe because the angular momentum of the blade would cause the blade to move down into the work zone with significant force when it was stopped and that downward movement could cause a serious injury. A person of ordinary skill would not combine the references as suggested by the examiner because of this problem.<sup>1</sup> This was explained in the Appeal Brief on pages 10 and 11, and it is an independent reason why there is no reasonable expectation that the combination of references proposed by the examiner would succeed. The examiner did not respond to this point.

Another reason why there is no reasonable expectation that the combination of references proposed by the examiner would succeed is that braking and detection systems like those disclosed in Lokey and Yoneda could not be incorporated into a miter saw as disclosed in Brundage or Suzuki. (Appeal Brief, 7-9.) The examiner responded to this issue, not by saying the braking and detection systems could be incorporated into a miter saw, but by saying this was not the question to ask. Specifically, the examiner said:

In this case, it is not a question of [whether] the specific structural elements of Lokey and Yoneda are incorporated into the structure of Brundage or Suzuki but rather what the combination of references

---

<sup>1</sup> Applicant overcame the issue of how to stop a miter saw blade without causing it to move down into the work zone as explained in applicant's specification.

discloses, i.e., a miter saw with a braking mechanism for stopping a blade upon detection of contact between the user and the blade. (Examiner's Answer, 5.)

Applicant disagrees; it is important to know whether the specific braking and detection systems disclosed in Lokey and Yoneda could be incorporated in a miter saw because the cited references must enable not only the individual limitations, but also the claimed combination. In other words, the cited references "must place the *claimed invention* in the possession of the public. ... An invention is not 'possessed' absent some known or obvious way to make it." In re Payne, 606 F.2d 303, 314, 203 USPQ 245 (CCPA 1979) (citations omitted, emphasis added). Thus, to support the obviousness rejection, Brundage, Suzuki, Lokey and Yoneda must disclose enough information so that a person of ordinary skill in the art could make a miter saw as claimed, with all its limitations. The cited references, however, do not disclose sufficient information because the braking and detection systems disclosed by Lokey and Yoneda would not work in the miter saws of Brundage or Suzuki. Because those braking and detection systems would not work in a miter saw, there is no reason to think a person of ordinary skill would combine the references as suggested by the examiner. The examiner did not rebut this fact.

The examiner also said "the specifics of the structural elements of Lokey and Yoneda are irrelevant given the current claims have no specifics to structural details for providing the braking/detecting functions." (Examiner's Answer, 5.) This statement confuses what the cited references enable with what the claims recite, and it imposes an incorrect legal standard, namely, that the structural details of the cited references are irrelevant in an obviousness analysis if the examiner concludes that the claims under

review lack structural details. As explained, the structural details disclosed by Lokey and Yoneda are directly relevant to the question of whether Lokey and Yoneda disclose information sufficient to enable a miter saw as recited in claim 9. If they do not, then Lokey and Yoneda cannot support an obviousness rejection regardless of whether claim 9 includes what the examiner considers to be "structural details." In the case at hand, the cited references fail to enable a miter saw as recited in claim 9 because those references do not teach how contact detection and braking systems could be incorporated in a miter saw.<sup>2</sup>

One of the reasons Lokey and Yoneda fail to enable a miter saw as recited in claim 9 is that the brakes disclosed in Lokey are too slow to use with a contact detection system as disclosed in Yoneda; a person would be seriously injured in the time it took the brakes to stop the blade. (Appeal Brief, 8.) The examiner did not dispute the fact that Lokey's brakes are too slow, but he said this fact was not persuasive because the "claims of the instant application do not recite how fast the brake mechanism should be activated or how fast the circular blade should be stopped when contact between a user and the circular saw is detected." (Examiner's Answer, 7.) Again, the examiner is confusing the issues. Whether claim 9 recites how fast the brake should be activated or how fast the blade should be stopped is irrelevant to whether Lokey and Yoneda enable a miter saw as claimed. Because Lokey's brake is too slow, a person of ordinary skill

---

<sup>2</sup> Applicant also disagrees with the examiner's statement that claim 9 has no "structural details." The brake mechanism itself is structure adapted to stop rotation of the blade. The fact that the limitation may also include functional language does not mean that the brake mechanism is non-structural. But even if the brake mechanism limitation was considered solely a functional limitation, that would not change the test for determining obviousness, nor would it change what the cited references teach. The references still would have to enable a miter saw capable of functioning as specified in claim 9, and they do not.

would not think it could be successfully used with a contact detection system, and therefore Lokey and Yoneda fail to enable a miter saw as recited in claim 9 regardless of whether claim 9 specifies how fast the brake mechanism should be activated. Other reasons why Lokey and Yoneda fail to enable a miter saw as recited in claim 9 are given in the Appeal Brief on pages 7-9.

**2. The references teach away.**

The cited references teach away from a miter saw with contact detection and braking systems because Lokey discloses a proximity detection system. In light of that teaching, a person of ordinary skill would more likely try to incorporate a proximity detection system in a miter saw rather than a contact detection system because a proximity detection system would completely avoid injuries, if it worked reliably.

The examiner responded by saying "Lokey does not teach that the safety mechanism completely avoids injuries to a user." (Examiner's Answer, 6.) That is incorrect. Lokey explicitly teaches: "The movement of the brakes 24 into engagement with the blade 13 is virtually instantaneous and the blade 13 stops prior to even the slightest contact with the body of the user regardless of the speed of movement of the users [sic] finger toward a contacting position with respect to the blade 13." (Column 2, lines 25-30.) No where does Lokey imply anything other than complete avoidance of injury. But even if the examiner's statement were true, Lokey would still teach away from a miter saw as recited in claim 9 because Lokey teaches proximity detection.

The examiner also said, "the capacitance sensor in Lokey can be tuned in a manner that the brake mechanism stops the rotation of the blade when there is contact between a person and the circular saw." (Examiner's Answer, 6.) Nothing in Lokey

supports that conclusion. To the contrary, Lokey teaches proximity detection only. Lokey discloses an adjustment knob 19, but nothing in Lokey suggests that turning the knob to the minimum setting will detect contact. It is more likely that turning knob 19 to the minimum setting will simply cause the sensor to detect close proximity because detecting proximity is all that Lokey teaches. Nevertheless, even if the examiner's statement were true, Lokey would still teach away from a miter saw as recited in claim 9 because Lokey teaches proximity detection.

The examiner tries to avoid the conclusion that Lokey teaches away from a contact detection system by saying, "The use of contact detection system and proximity detection system are two art-recognized alternatives for the safety systems in cutting apparatus." (Examiner's Answer, 6.) This conclusion is also unsupported. No reference suggests that a contact detection system could work in a circular saw like a miter saw. To the contrary, the only disclosures of a contact detection system are in the context of band cutters, such as disclosed in Yoneda, and none of those disclosures suggest that contact detection systems could work in miter saws. It is speculation for the examiner to conclude otherwise.

### 3. No teaching, suggestion or motivation.

The examiner says it would have been obvious to combine the cited references "in order to prevent injuries to a user" because the detection system of Lokey "can be tuned" to detect contact. (Examiner's Answer, 5-6.) That conclusion is incorrect because nothing suggests that Lokey can be tuned to detect contact, as explained previously. Moreover, the combination of contact detection and braking systems in a miter saw would not "prevent injury;" it would require an injury because the modified saw would



detect contact instead of proximity. If anything, the desire "to prevent injuries" would motivate a person to try and use proximity detection instead of contact detection. Finally, the desire "to prevent injuries" is simply a rote invocation of the desire for safer products, and therefore, is an insufficient motivation to combine references in an obviousness analysis. See, e.g., In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453 (Fed. Cir. 1998); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (citations omitted), *abrogated on other grounds in In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000).

#### 4. Objective indicia of non-obviousness.

The examiner did not deny or rebut the fact that there has been a long felt but unsatisfied need for safer woodworking machines, as demonstrated by the continuing high number of injuries and the failure of systems like those disclosed in Lokey and Yoneda to address those injuries. The examiner also did not deny or rebut the fact that the technology which is the basis for miter saws constructed as required by claim 9 has been recognized as new and innovative by various entities associated with the woodworking industry. These facts support a conclusion of non-obviousness.

#### II. Claim 30.

The examiner did not separately address applicant's comments concerning claim 30.

#### **8. Claims appendix.**

The claims are set forth in the Appeal Brief.

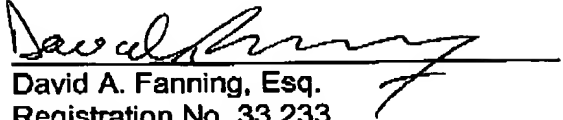
#### **9. Evidence appendix.**

Identified in the Appeal Brief.

**10. Related proceedings appendix.**

None.

Respectfully submitted,  
SD3, LLC

  
David A. Fanning, Esq.  
Registration No. 33,233  
Customer No. 27630  
25977 S.W. Canyon Creek Road, Suite G  
Wilsonville, Oregon 97070  
Telephone: (503) 570-3200  
Facsimile: (503) 570-3303

**CERTIFICATE OF TRANSMISSION/MAILING**

I hereby certify that this Reply Brief is being deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or facsimile transmitted to the U.S. Patent and Trademark Office to number (571) 273-8300, on the date shown below.

Date: July 11, 2006

  
David A. Fanning